

Remarks

For the Information Disclosure:

The above-identified application is related to, and copending with, "Method For Providing Location Information Of A Wireless Communication Device," by Rajamani Ganesh, U.S. Patent Application Serial Number 10/032,202. An Office Action, dated 15 July 2004, was recently received in connection with the copending application, Serial Number 10/032,202. A supplemental information disclosure statement citing all references revealed in the 15 July 2004 Office Action to the copending application (Serial Number 10/032,202), and all references listed in the supplemental information disclosure statement, are being submitted herewith for the Examiner's consideration.

For the Drawings:

This Office Action indicates that the drawings are objected to by the draftsperson under 37 CFR 1.84(I)(P). This Office Action requires drawing correction. In general, the draftsperson objects to the informal drawings (Figures 1-7) because lines, numbers, and letters are not uniformly thick and well defined, clean, durable, and black and/or numbers and reference characters are not plain and legible. Formal drawings are being submitted herewith, wherefore it is respectfully requested that the objection be withdrawn.

For the Specification:

Applicant amends the specification beginning on page 1, line 5, to include the previously unknown serial number of the

AMENDMENT

SERIAL NO. 10/032,355

Page: 11

related, copending application. This amendment adds no new subject matter.

For the Claims:

Applicant submitted claims 1-23. This Office Action rejects claims 1-23. Applicant cancels claims 6, 16-17, 19, and 21-23, amends claims 1, 7, 9, and 18, adds claims 24-31, and retains claims 2-5, 8, 10-15, and 20 as originally submitted. Claims 1-5, 7-15, 18, 20, and 24-31 are pending. Applicant respectfully requests reconsideration.

This Office Action rejects claims 1, 10-13, 15, and 20 under 35 U.S.C. 102(b) as being anticipated by *Wallace*, U.S. Patent No. 6,463,272. *Wallace* teaches of a pager that includes a global positioning system receiver so that the pager may be interrogated by a remote requester for the user's current location. The Office Action alleges that *Wallace* teaches the invention of claims 1, 10-13, 15, and 20.

Independent claim 1 is being amended to include the limitations of dependent claim 6. Consequently, claim 6 is being canceled. In addition, claim 7 is being amended to correct its dependency in response to the cancellation of claim 6. That is, claim 7 is being amended to now depend from claim 1. Claim 9 is being amended to correct a term that was lacking antecedent basis. New claim 24 depends from claim 1 and more distinctly points out that which Applicant believes to be the invention.

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Wallace* in view of *Tanaka*, U.S. Patent No. 6,731,928 and further in view of *Chern*, U.S. Patent No. 6,609,005. *Tanaka* discloses a method for providing matching and

AMENDMENT

SERIAL NO. 10/032,355

Page: 12

introduction services to proximate mobile users and service providers. Chern teaches of a system and method for displaying the location of a wireless communications device on the display of the device. In light of the modifications to independent claim 1, the rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Wallace is overcome. Likewise, the rejection of claims 10-13 and 15 (which depend directly or indirectly from claim 1) under 35 U.S.C. 102(b) as being anticipated by Wallace is overcome.

Claim 20, as originally submitted, depends from claim 18. This Office Action rejects claim 18 under 35 U.S.C. §103(a) as being unpatentable over Wallace in view of Tanaka. Accordingly, the rejection of claim 20 under 35 U.S.C. 102(b) is improper because a rejection under 35 U.S.C. 102(b) requires the disclosure in a single prior art reference of each element of the claim under consideration. That is, since claim 20 depends from claim 18, the rejection of claim 18 also applies to claim 20. Consequently, this Office Action should have alleged that claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wallace in view of Tanaka. For the reasons set forth above, Applicant respectfully requests the withdrawal of the rejection of claims 1, 10-13, 15, and 20 under 35 U.S.C. 102(b).

In a summary sentence presented on page 4, this Office Action rejects claims 2, 3, 4, 14, and 18 under 35 U.S.C. 103(a) as being unpatentable over Wallace in view of Tanaka. Pages 5 and 6 of this Office Action present arguments indicating that claims 16-17 and 21-23 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace in view of Tanaka. Accordingly, Applicant takes the position that claims 16-17 and 21-23 are also being rejected over a combination of Wallace and Tanaka. However, since claims 16-17 and 21-23 are being canceled in this

AMENDMENT

SERIAL NO. 10/032,355

Page: 13

Amendment, the presumed rejection of claims 16-17 and 21-23 over a combination of *Wallace* and *Tanaka* is moot.

In another summary sentence presented on page 6, this Office Action rejects claims 5, 6, 7, 9, and 19 under 35 U.S.C. 103(a) as being unpatentable over *Wallace* in view of *Tanaka*, applied above, and further in view of *Chern*. Page 8 of this Office Action presents arguments indicating that claim 23 is also rejected under 35 U.S.C. 103(a) as being unpatentable over *Wallace* in view of *Tanaka* and further in view of *Chern*.

Accordingly, Applicant takes the position that claim 23 is also being rejected over a combination of *Wallace*, *Tanaka*, and *Chern*.

In addition, this Office Action rejects claim 8 under 35 U.S.C. 103(a) as being unpatentable over *Wallace* in view of *Tanaka*, and in view of *Chern*, and further in view of *Beamish*, U.S. Patent No. 6,694,143.

Regarding the rejection of claim 6, now applicable to amended independent claim 1, this Office Action indicates that claim 6 was rendered obvious in view of a hypothetical combination of *Wallace*, *Tanaka*, and *Chern*. However, claim 6 originally depended from claim 1, which is only rejected in view of the *Wallace* reference. In addition, claims 7 and 9 depended directly or indirectly from claim 6. This Office Action merely provides explanation on pages 6-8 as to the alleged obviousness of claims 6, 7, and 9 in view of *Chern*. Accordingly, Applicant takes the position that the rejection of the originally submitted claims 6, 7, and 9 should have been in view of a hypothetical combination of only *Wallace* and *Chern*.

Since the limitations of claim 6 have now been included in independent claim 1, a "rejection" of claim 6 in view of a

AMENDMENT

SERIAL NO. 10/032,355

Page: 14

hypothetical combination of *Wallace* and *Chern* is now applicable to amended independent claim 1. Similarly, since claim 7 depends from claim 6 and claim 9 depends from claim 7, Applicant presumes that claims 7 and 9 are "rejected" in view of a hypothetical combination of only *Wallace* and *Chern*.

This Office Action alleges that *Wallace* largely teaches the claim 1 limitations of receiving a request for a current location of a wireless communication device from a requesting party, verifying that the requesting party is an authorized party, activating a location determination process to determine the current location of the wireless communication device, and supplying an indicator of the current location to the requesting party.

Amended independent claim 1 now recites the further limitations, formerly recited in claim 6, of the activating operation including predicting a potential location area of the wireless communication device and initiating the location determination process in the potential location area. This Office Action alleges that *Chern* discloses the predicting and initiating operations of claim 6, now recited in amended independent claim 1. This Office Action cites column 5, lines 48-60, of the *Chern* reference as providing this alleged disclosure.

The passage in *Chern* cited in this Office Action discloses a position determination system that uses the Global Positioning System (GPS) or differential GPS. *Chern* further discloses that alternative position determination systems, such as triangulation systems, may also be used.

AMENDMENT

SERIAL NO. 10/032,355

Page: 15

Applicant believes that a combination of *Wallace* and *Chern* fails to render obvious the invention of amended independent claim 1. As stated in In re Wood, 202 USPQ 171, 174 (C.C.P.A. 1979):

The test for obviousness is not whether the features of one reference may be bodily incorporated into another reference....Rather, we look to see whether combined teachings render the claimed subject matter obvious.

While both *Wallace* and *Chern* teach of location/position determination in general terms, neither *Wallace* nor *Chern* teach or suggest Applicant's operations of predicting a potential location area of the wireless communication device and initiating the location determination process in the potential location area, as recited in amended independent claim 1.

Applicant's predicting operation is performed so that the location determination process can be initiated in the most likely area in which the wireless communication device may be located. A prediction advantageously localizes a search for the wireless communication device irrespective of a current registration of the wireless communication device. Since neither *Wallace* nor *Chern* teach or suggest Applicant's predicting and initiating operations, a combination of *Wallace* and *Chern* also cannot suggest Applicant's claimed predicting and initiating operations. Rather, it is only that which Applicant teaches that is being used against its teacher. However, it is improper to read obviousness into an invention on the basis of Applicant's teachings.

Accordingly, for the reasons set forth above, Applicant believes amended independent claim 1 is allowable. Claims 2-5, 7-15, and new claim 24 depend directly or indirectly from claim 1. As such, claims 2-5, 7-15, and 24 are also allowable for the

AMENDMENT

SERIAL NO. 10/032,355

Page: 16

reasons set forth above. In addition, claims 2-5, 7-15, and 24 are allowable for independent reasons.

For example, claim 9 includes the further limitation that the determining operation includes ascertaining the potential location area from a comprehensive call history database of the network provided by a service provider, where the comprehensive call history database includes call records of past calls in which the wireless communication device participated. Claim 9 depends from claim 8, which depends from claim 7, which now depends from claim 1. Claim 9 was rejected in view of a combination of *Wallace*, in view of *Tanaka* "applied above", and further in view of *Chern*.

This Office Action alleges that *Chern* discloses the features of claim 9. This Office Action cites FIG. 2, element 138, and col. 7, lines 5-45, as the alleged disclosure of Applicant's invention of claim 9. *Chern* discloses in the cited figure and passage a database 138 associated with a server 136 that contains "relevant information" (col. 6, lines 11-18). *Chern* further teaches that this relevant information is "virtually limitless", but provides several examples for illustrative purposes. The examples include driving directions to a destination address (col. 6, lines 19-20), particular types of businesses or services in the user's location (col. 6, lines 38-41), and so forth. This memory-intensive data may be stored in database 138 to minimize the amount of memory required in the *Chern* handset (col. 7, lines 1-11). Accordingly, database 138 is a data storage unit from which information can be retrieved in response to handset user queries.

The *Chern* database is not a teaching or a suggestion of ascertaining the potential location area from a comprehensive

call history database of the network provided by a service provider, the comprehensive call history database including call records of past calls in which the wireless communication device participated, as recited in claim 9. Indeed, the *Chern* database has nothing to do with ascertaining a location of the *Chern* wireless handset. Instead, the *Chern* database provides locations, listings, maps, and so forth of establishments after the location of the *Chern* wireless handset is known.

The collection of call records of past calls and maintenance of a comprehensive call history database is not related to wireless communication device location, or to the location of establishments after the location of the *Chern* wireless handset is known. Rather, a cellular service provider collects call-history information for a call in a comprehensive call history database of call records for the subscribers operating in the wireless communication network. These call records are utilized by the service provider for record keeping purposes, such as billing and for providing subscribers with enhanced services, such as last numbers dialed, caller ID, and so forth (Applicant's specification page 7, lines 9-28).

Applicant has discovered that these call records, presently accumulated in the comprehensive call history database, may be advantageously utilized to predict a potential location area of a wireless communication device, hence its user. Moreover, since the comprehensive call history database is existing, service providers can readily, and cost effectively, implement this into a current location information service.

Only Applicant teaches of ascertaining the potential location area from a comprehensive call history database of the network provided by a service provider, the comprehensive call history

AMENDMENT

SERIAL NO. 10/032,355

Page: 18

database including call records of past calls in which the wireless communication device participated, as recited in claim 9. That is, when *Wallace* and *Chern* are reviewed without the benefits of Applicant's disclosure it is readily apparent that a combination of *Wallace* and *Chern* fails to render obvious Applicant's invention of claim 9. Accordingly, for the reasons set forth above, Applicant believes claim 9 is allowable.

Independent claim 18 was amended to include the further limitations, formerly recited in claim 19 (now canceled), of the activating operation including predicting a potential location area of the wireless communication device and initiating the location determination process in the potential location area. Accordingly, Applicant believes claim 18 to be allowable for the reasons set forth in connection with claim 1.

New claims 25-31 have been added to more clearly point out and distinctly claim that which Applicant believes to be the invention. The subject matter of claims 25-31 is described in Applicant's specification on page 8, line 6, through page 15, line 9. No new matter is being added.

Accordingly, this Amendment cancels claims 6, 16-17, 19, and 21-23, amends claims 1, 7, 9, and 18, and adds claims 24-31. Currently amended claims 1, 7, 9, and 18 remain in the application and are believed to be allowable. In addition, claims 2-5, 8, 10-15, and 20 remain in the application as originally submitted, and new claims 24-31 are included in the application, all of which are believed to be allowable.

AMENDMENT

SERIAL NO. 10/032,355

Page: 19

Applicant believes that the foregoing amendments and remarks are fully responsive to the rejections and/or objections recited in the 9 July 2004 Office Action and that the present application is now in a condition for allowance. Accordingly, reconsideration and allowance of the present application is respectfully requested. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to patent office deposit account 07-2347. Please charge any other fees required or credit any overpayment to this deposit account.

Respectfully submitted,



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